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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/240,524 | 01/29/1999 | ROBERT JAMES GERNDT | KCC-14-026 | 7431 |

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| EXAMINER |
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ATKINSON, CHRISTOPHER MARK

| ART UNIT | PAPER NUMBER |
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3743

DATE MAILED: 03/22/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/240,524

Applicant(s)

Gerndt et al.

Examiner

Atkinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/26/01
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Response to Remarks

Applicant's arguments filed 10/26/2001 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scannell in view of Schonemann or Akiyoshi et al. or Marschke.

The patent of Scannell in Figures 1-3 and 5 discloses all the claimed features with the exception of the passage extending between the inlet and outlet ends of the roller.

The patents of Schonemann, Akiyoshi et al. and Marschke disclose that it is known to

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have a passage between the inlet and outlet ends of a roller for the purpose of saving space and manufacturing costs (i.e. using less tubing in the plumbing of the fluid supply and removal system) by delivering and removing a fluid to and from only one end of the roller. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Scannell the passage between the inlet and outlet ends of the roller for the purpose of saving space and manufacturing costs by delivering and removing the fluid to and from only one end of the roller as disclosed in Schonemann, Akiyoshi et al. and Marschke. The claimed number of channels is considered to be an obvious design choice which does not solve any stated problem or produce any new and/or unexpected result. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have two rollers, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Also, Akiyoshi et al. teaches two rollers.

Response to Arguments

Regarding applicant's concerns directed toward the motivation of combining the references, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Also, there is not requirement that the motivation for combining references be the same reason that applicant has given. See *In re Dillon*, 16 USPQ 2d 1897. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of

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the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the documents of Schonemann in at least figures 2 and 4-5, Akiyoshi et al. in at least figure 1, and Marschke in figures 2, 6 and 9-10 disclose that it is known to have a passage between the inlet and outlet ends of a roller for the purpose of saving space and manufacturing costs (i.e. using less tubing in the plumbing of the fluid supply and removal system) by delivering and removing a fluid to and from only one end of the roller. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Scannell the passage between the inlet and outlet ends of the roller for the purpose of saving space and manufacturing costs by delivering and removing the fluid to and from only one end of the roller as disclosed in Schonemann, Akiyoshi et al. and Marschke.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). At least figure 5 in Scannell discloses a plurality of channels extending radially (see channel/passage between elements 74a-74f in figure 5) outward and becomes progressively wider as it approaches an annulus between the inner and outer rolls. The teaching of cleaning is capping the passage end. It does not matter if

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the passage is capped and extends at only one end of the roll or if the passage is capped and extends the entire length of the roll.

In response to applicant's argument directed toward Schonemann, Akiyoshi et al. and Marschke, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, all of applicant's arguments stating the each of Schonemann, Akiyoshi et al. and Marschke teach away from being combined with Scannell are not based on any facts but are just mere proposed allegations. The only teaching taken from teach of the Schonemann, Akiyoshi et al. and Marschke is that it is known to have a passage between the inlet and outlet ends of a roller for the purpose of saving space and manufacturing costs (i.e. using less tubing in the plumbing of the fluid supply and removal system) by delivering and removing a fluid to and from only one end of the roller. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Scannell the passage between the inlet and outlet ends of the roller for the purpose of saving space and manufacturing costs by delivering and removing the fluid to and from only one end of the roller as taught in each of Schonemann, Akiyoshi et al. and Marschke.

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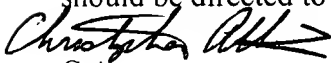
Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Atkinson whose telephone number is (703) 308-2603.



C.A.

March 21, 2002

CHRISTOPHER ATKINSON
PRIMARY EXAMINER